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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,098	07/28/2003	Jack R. Pfeffer	12,533	3517

7590 01/13/2005

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EXAMINER

SPERTY, ARDEN B

ART UNIT PAPER NUMBER

1771

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,098

Applicant(s)

PFEFFER, JACK R.

Examiner

Arden B. Sperty

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1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Application filed 7/28/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-25 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 15-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/28/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

FIRST OFFICE ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is not enabled for a sheet having a thickness as low as the claimed endpoint of 0.25 inches. The lowest endpoint found in the specification is 0.75 inches.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2, 7 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The structure implied by "wool-like" is unclear. In what way is the first layer like a wool?

5. Regarding claim 14, the claim language does not clearly state what applicant intends by performing the method step while the composite sheet is "being transported." Clarification of the implied step is required. Stating that the composite sheet is

transported "on a conveyor," as is disclosed in the specification, would overcome the present rejection.

Claim Interpretation

6. It is interpreted that the second layer of claim 1 is a layer of binder. Therefore, the structure includes a first layer of homogenized glass fiber and binder, a second layer of binder, and a third layer of a woven glass fiber cloth. The binder referred to in part d) of claim 1 is the binder of the first layer and the second layer. No binder is necessarily implied in the third layer.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5560985 to Watanabe et al.

9. The Watanabe reference teaches a composite product comprising glass fibers and binder material. Figures 1(a) and 1(b), both of layers 2 and 6 comprise a woven glass fabric (col. 3, lines 49-59) analogous to Applicant's claimed third layer. The woven glass fabric layer may comprise binder, but also may be a woven glass fabric without binder (col. 5, lines 61-66). Layers 2 and 6 are next to layers 3 and 5, respectively. Layers 3 and 5 comprise thermoplastic resin reinforced with a random mat (col. 3, lines

34-37), i.e. a non-woven glass (col 4, lines 4-23). Each of layers 3 and 5 are analogous to the combination of Applicant's first and second layers. In other words, layer 3, comprising a thermoplastic resin reinforced with a non-woven glass is analogous to the combination of Applicant's glass fiber and binder material of the first layer, next to a layer of binder material constituting the second layer.

10. It is the examiner's interpretation that the non-woven glass fiber mat of the reference meets the "wool-like" limitation of claim 2.

11. Regarding claim 4, the process limitation of the claim is considered with respect to the structure imparted to the final product. While the reference may not use the same process steps as in claim 4, the final product is the same. Therefore, the structure of the claim is anticipated by the prior art.

12. Claim 9 is met by the teaching of the reference of layers 2 and 6 as formed alone, or without binder (col. 5, lines 61-66).

13. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6333280 to Hashimoto et al.

14. The reference teaches flame-retardant laminates comprising glass fibers. Specifically, Figure 3 shows the product of Example 3 (columns 6-7), comprising a decorative layer 2 analogous to the claimed first layer. Material for the decorative layer includes glass fiber and thermosetting resin (col. 4, line 60- col. 5, line 4). The core layer 5 is analogous to Applicant's claimed second layer, taught in Example 3 as comprising organic binder and a non-woven fabric (col. 6, lines 63+). The reinforcing layer 6 is

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analogous to the claimed third layer. The reinforcing layer is a glass woven fabric (col. 7, lines 9-15).

15. It is the examiner's interpretation that the decorative layer of the reference meets the "wool-like" limitation of claim 2.

16. Regarding claim 4, the process limitation of the claim is considered with respect to the structure imparted to the final product. While the reference may not use the same process steps as in claim 4, the final product is the same. Therefore, the structure of the claim is anticipated by the prior art.

17. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4187275 to Bracalielly.

18. Drying and curing a sheet on a conveyor belt is notoriously well-known, as evidenced by the Bracalielly reference (column 4, lines 1-7), therefore the process limitations of claim 14 are met.

Claim Rejections - 35 USC § 102/103

19. Claims 5, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6333280 to Hashimoto et al.

20. While Hashimoto is not concerned with the dimensions of the fibers of the decorative layer, which corresponds to the claimed first layer, the claimed dimensions are common and thus it is reasonable to presume they are inherently anticipated by the range of materials. The burden is shifted to applicant to show otherwise. *In re*

Fitzgerald, 205 USPQ 495. In addition, the claimed fiber dimensions would obviously have been present when using the disclosed materials. In re Best, 195 USPQ 433.

Therefore,

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 7-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6333280 to Hashimoto et al.

23. It would have been obvious to one of ordinary skill in the art to provide the optimal basis weight according to the ultimate intended use of the product, thus no patentable distinction is seen in the claimed values.

Allowable Subject Matter

24. Claims 15- 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: While drying and curing a sheet on a conveyor is notoriously well-known, the temperature and curing time are dependent upon the materials used, and thus are not taught or fairly suggested by the cited reference.

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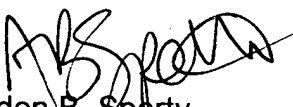
25. Claims 23-25 are allowable as drafted. Claim 23 is understood to include all limitations of claim 1. The claimed combination of elements is neither taught nor fairly suggested by the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Arden B. Sperty
Examiner
Art Unit 1771

January 3, 2005